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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,718	10/22/2003	Shinji Shiraga	00862.023290	3954
5514 7590 11/16/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER TAYLOR, NICHOLAS R	
			ART UNIT 2141	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/689,718

Applicant(s)

SHIRAGA, SHINJI

Examiner

Nicholas R. Taylor

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-10,14-16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-10,14-16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/23/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1, 2, 6-10, 14-16, and 19-21 have been presented for examination and are rejected.
2. The proposed amendments to the specification and claims filed on August 23rd, 2007, are approved. The rejections under 35 U.S.C. §112 and §101 are withdrawn.

### ***Response to Arguments***

3. Applicant's arguments filed August 23rd, 2007, with respect to the claims have been considered but are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6-10, 14-16, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehara et al. (U.S. PGPub 2002/0069237) and Zondervan et al. (U.S. Patent 7,185,286)

6. As per claims 1, 9, 19, 20, and 21, Ehara teaches a file transfer method for transferring one or more files recorded on a removable recording medium via a network to a predetermined server, said method comprising:

a step of reading, from said removable recording medium said one or more files and a positional information of a transfer destination of said file recorded on said removable recording medium; and (Ehara, recordable medium of paragraph 0054-0058 and fig. 2, that contains positional information in paragraph 0063)

a step of transferring said one or more read files to a specific region on a server specified by the read positional information; (Ehara, process of paragraphs 0061-0063 and the corresponding flowchart of fig. 3)

Ehara teaches the above, yet fails to teach

a step of accruing an indication from a user of whether or not to delete the one or more transferred files from the removable recording medium before the transmission of the one or more files by the transferring step when all the files stored in said removable recording medium are transferred to said server, and acquiring the indication from a user of whether or not to delete the one or more transferred files from the removable recording medium after the transmission of the one or more files by the transferring step when only files selected by the user from the files stored in said removable recording medium are transferred to said server; and

a step of deleting the one or more transferred files from the removable recording medium if the indication of deletion of files is acquired from the user.

Zondervan teaches a graphical user interface that includes an optionally

recordable file transfer protocol interaction with a database (see interactions of fig. 18, col. 4, lines 11-21, example at col. 26, lines 45-59) that enables acquisition of an indication from a user (col. 16, lines 45-63 file transfer workplace setting) before transmission of one or more selected files (see col. 18, lines 43-53 and specifically fig. 28 where a "Delete after upload" indication is available next to a "test upload" command after selecting files).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ehara and Zondervan, because doing so would allow the creation and manipulation of transaction patterns that simplify content-based interaction (Zondervan, col. 1, lines 57-62). The combination would additionally provide the benefit of enabling users to increase free space by deleting unnecessary copies of files using pre-transactional parameters.

7. As per claims 2 and 10, Ehara-Zondervan teaches the system further wherein said positional information recorded on said recording medium is inhibited from rewriting (Ehara, recordable medium of paragraph 0054-0058 and fig. 2, which contains non rewritable media).

8. As per claims 6 and 14, Ehara-Zondervan teaches the system further wherein said positional information indicates a specific region on any one of said plurality of servers storing the file (Ehara, paragraphs 0062, 0069, and 0070).

9. As per claims 7 and 15, Ehara-Zondervan teaches the system further wherein said positional information recorded on said recording medium is different for each recording medium (Ehara, paragraph 0063 where the positional information is predetermined and specific to the drive).

10. As per claims 8 and 16, Ehara-Zondervan teaches the system further wherein said positional information is recorded on said recording medium before the shipment of said memory card or selling it to the customer (Ehara, paragraph 0063 where the positional information is predetermined and specific to the drive).

### ***Conclusion***

11. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Application/Control Number:  
10/689,718  
Art Unit: 2141

Page 6

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NT 11-1-07

Nicholas Taylor  
Examiner  
Art Unit 2141

  
JASON CARDONE  
SUPERVISORY PATENT EXAMINER